

Remarks

The Restriction Requirement contends that the claims as filed are directed to the following distinct inventions: (1) Group I (claims 1-14 and 22-28); (2) Group II (claims 15-17 and 29); Group III (claims 18-21, 32 and 33); and Group IV (claims 30 and 31). Applicant's attorney discussed the Restriction Requirement with Examiner Shaw in a telephone interview on July 7, 2005. It was agreed upon that Group I also includes claims 15, 16 and 29, since these claims depend from Group I claims.

Applicant elects, with traverse, Group I, claims 1-16 and 22-29 for prosecution in the present application. Applicant also elects the "species" of FIG. 1 of the present application. Claims 1-16 and 22-29 are readable on the FIG. 1 species. For the following reasons, Applicant also requests rejoinder of the claims of Groups II-IV with the Group I claims for prosecution in the present application.

I. No Serious Burden

MPEP § 803 states that "If a search and examination of an entire application can be made without serious burden, the Examiner must examine [the entire application] on the merits, even though it includes claims to independent or distinct inventions." As reported in the Office action dated November 24, 2004, a search and examination already have been performed for all of the pending claims in the present application. Furthermore, claims 1-17 and 22-31 already have been allowed by the Examiner. Since the inclusion of all claims in the present application would not impose any additional burden on the Examiner, MPEP § 803 requires that the restriction be withdrawn.

II. Groups I and II

The Restriction contends that Groups I and II are related as a subcombination and a combination and that they are distinct because the "subcombination has separate utility such as when no pressure is needed on the nose band, as on display in a store." Applicant disagrees with this contention. When on display in a store, the horse control device is not being used, and therefore does not have any utility in this regard. (Of course, when properly construed, all

pending claims would cover all infringing acts under 35 U.S.C. § 271, regardless of whether an infringing act is an actual use.)

Applicant submits that the phrase “separate utility” under MPEP § 806.05(c) means actual use of a device. If the phrase “separate utility” is interpreted to include non-uses of a device (such as when displayed in a store), then the requirement that the Patent Office show that the subcombination in question has separate utility would be rendered meaningless, since all devices (even those without any known utility) can be shown or displayed. Hence, Groups I and II have not been shown to be distinct under MPEP § 806.05(c), and the restriction as to these groups must be withdrawn.

III. Groups III and I/II

The Restriction contends that Groups III and I/II are related as a subcombination and a combination and that they are distinct because the “subcombination has separate utility such as when no pressure is needed on the poll strap, as on display in a store.” Applicant submits that Groups III and I/II have not been shown to be distinct, since displaying the device in a store is not an actual use as required under MPEP § 806.05(c). Thus, the restriction as to Groups III and I/II must be withdrawn.

IV. Groups I/II/III and IV

The Restriction contends that Groups IV and I/II/III are related as a process and an apparatus for its practice and that they are distinct because the apparatus “can be used to practice another materially different process such as where tension is never applied to the first resilient nose band, as on display in a store.” Applicant disagrees with this contention.

Like the alternative use proposed by the Examiner, the method as claimed includes the step of *removing tension from the first nose band* (as recited in claim 31). Furthermore, if the apparatus is displayed in a store, prospective customers undoubtedly will pick up and test the apparatus by tensioning the nose band. Since the alternative use proposed by the Examiner and the method as recited in the Group IV claims include similar steps (tensioning a nose band and releasing the tension on the nose band), they clearly are not materially different from each other. Thus, the claims of Group IV and the claims of Groups I/II/III have not been shown to be distinct under MPEP § 806.05(e), and the restriction as to these groups must be withdrawn.

In addition, as indicated in the Examiner's Search Notes, class 54, subclass 6.2 (the Group IV claims) already has been searched. The inclusion of the Group IV claims with the elected Group I claims would not impose any further burden on the Examiner. Thus, under MPEP § 803, this restriction should be withdrawn.


V. Conclusion

For at least the foregoing reasons, Groups I, II, III, and IV should be included in the present application. The Examiner is invited to call the undersigned if there are any issues remaining concerning this matter.

Respectfully submitted,

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